

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claims 1 and 4-6 are amended. Support for the amendments can be found on at least page 7, lines 28-28 and Fig. 6 of Applicants' Specification. Claims 1 and 4-6 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

In paragraph 4 on page 3 of the Office Action, claims 1, 4-6 were rejected as being unpatentable over Smith (US 6,187,213) in view of case law and further in view of applicant's own disclosure. Applicants respectfully traverse the rejection.

Smith fails to teach or suggest at least a near-field optical device to alter the color in a plurality of areas in a gemstone without ablating the areas to form a micro-discrete indicia image on a surface of the gemstone, the micro-discrete indicia image having a length no greater than about 10 microns and a height no greater than about 2 microns. Rather, Smith discloses ablating a diamond to make shallow marks in the diamond and avoiding undesirable darkening in the marks due to phase transformation. Col. 4, lines 21-23 and Col. 4, line 65 – Col. 5, line 5. Further, Smith does not disclose a near-field optical device to alter the color in a plurality of areas in a gemstone.

Applicants' admitted statement fails to remedy the deficiencies of Smith as Applicants' admitted statement does not disclose a near-field optical device to alter the color in a plurality of areas in a gemstone without ablating the areas to form a micro-discrete indicia image on a surface of the gemstone is known by those skilled in the art.

In addition, Applicants' respectfully disagree with the Office Actions assertion that "one of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious." Applicants respectfully submit that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's

personal knowledge or submit a prior art reference suggesting the desirability of modification. Moreover, in *Toledo Computing Scale Co. v. Computing Scale Co.*, the Court granted a patent covering capillary tubing, as the new tubing was effective only by reason of its size. 208 F. 410 (C.C.A. 1913) (The reduction in the cross-sectional area of the tubing converted failure into success, and involved something more than a matter of degree).

Also, Applicants do not agree with Examiner's assertion "that the printed matter is not functionally related to the product." Applicants submit, with respect to claims 5 and 6, that the micro-discrete indicia provide information with regard to the gemstone. This specifies the required functional relationship to carry out Applicants' invention and clearly defines the disclosed invention as required by section 112. "The fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination." *In re Miller*, 418 F.2d 1392, 1395; 164 USPQ 46, 48 (1969) (A new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio.)

Therefore, in view of the above remarks, Applicants independent claim 1 is patentable over the cited reference. Because claims 4-6 depend from claim 1, and include the features recited in the independent claim, Applicants respectfully submit that claims 4-6 are also patentably distinct over the cited reference. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

Respectfully submitted,



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